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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,867	06/01/2001	Peter J. Malnekoff	MAL6115P0011US	2171

7590

02/26/2003

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EXAMINER

KEMPER, MELANIE A

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 02/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary

Application No.

09/871,867

Applicant(s)

MALNEKOFF, PETER J.

Examiner

M Kemper

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 18-19 is/are rejected.
- 7) ☒ Claim(s) 16 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-15,18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal, patent number 6,239,867 in view of Newman et al., "A Multimedia Solution to Productivity Gridlock: A Re-Engineered Jewelry Appraisal System at Zale Corporation" MIS Quarterly, v. 18, n. 1, 3/1994.

Aggarwal teaches an input device for receiving gemstone data including cut type, weight, color, clarity, girdle thickness (see at least col. 3, lines 25-65, col. 4, lines 15-40, col. 14, lines 40-65); a processing device for computing a pricing estimate for use in a consumer evaluation report based upon the gemstone data (col. 16, lines 25-40, claims 25-26, 31); and an output device for communicating the report (col. 16, lines 35-40, col. 7, lines 5-10). Aggarwal does not clearly teach receiving predetermined gemstone data supplied by a user, however, a data file is accepted. It would have been obvious to one having ordinary skill in the art at the time of the invention to have inputted predetermined gemstone data in the automated evaluation system of Aggarwal since accepting predetermined data would have been adopted for the intended use of generating a data file of a gemstone or for the intended use of general query of the database for current market price information (col. 16, lines 25-40, claims 31, 34,35). Aggarwal also teaches the report includes a summary description, a remote communication

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section, a printer for printing the report, and a display for displaying the report (see at least col. 2, lines 40-60, col. 3, lines 10-15, col. 4, lines 45-55, col. 6, lines 50-60, col. 7, lines 30-40, col. 16, lines 25-45).

Newman teaches inputting predetermined gemstone information into a processing device which looks up the fair market pricing estimate in an index (p. 24-26). It would have been obvious to one having ordinary skill in the art at the time of the invention to have used the predetermined gemstone information as in Newman in the system and method of Aggarwal inputting provided information would have saved time over measuring each gemstone feature. It also would have been obvious to have implemented the gem-pricing index as in Newman since this would have been adopted for the intended use of generating the current market price information used for appraisals of Aggarwal. It also would have been obvious to have included a separate price estimate for each of a plurality of types of retail outlets since this would have been adopted for the intended use of providing the market price range provided in Aggarwal/Newman. It also would have been obvious to have the system user be a consumer in order to allow the user to determine updated appraisal information.

1. Claims 16-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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1. Applicant's arguments filed on 11/15/02 have been fully considered but they are not persuasive. The applicant argues that the references teach that the presence of the gemstone is required. However, this is not given patentable weight since it does not further limit the structure of the claimed system. Further, Aggrawal teaches that the presence of the gemstone is not necessary since shipping gemstones for appraisal places inventory at risk (col. 2, lines, 40-60). Also, it is clear that only gemstone characteristics need to be known (not necessarily by having the gemstone present) in the form of data in order to query the database.

The applicant also argues that cut proportions are not taught. However, Aggrawal teaches data concerning cut proportions including table measurements, girdle thickness, pavilion angle at least in col. 15, lines 1-20. The applicant also argues that there is no desire or possibility of providing a separate price estimate for different types of retail outlets. However, the combination does suggest providing price estimates for different type of retail outlets since this would have been adopted for the intended use of providing the price range suggested by Aggrawal according to the types of retail outlets as taught by Newman (p. 24).

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "The Real Computer Payoff: part 3" provides a date of at least April 1995 for the Jewelry Judge.

Vig, patent number 5,911,131 teaches an automated appraisal with adjustment factors (fig. 1 and related text).

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No Author, "British Online Valuation Service Now Available Here" Irish Times,
7/10/98 (whole document).

2. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

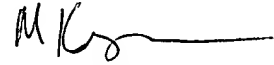
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to M Kemper whose telephone number is 703-305-9589. The examiner can normally be reached on M-F (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7240 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



M. Kemper
Primary Examiner
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MK
February 24, 2003